REMARKS/ARGUMENTS

In the Office action mailed December 10, 2008, claims 1-27 were rejected under 35 U.S.C. 112, first paragraph and claims 1 and 16 were rejected under 35 U.S.C. 112, second paragraph. In addition, claims 1-10 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,737,539 to Edelson et al. ("Edelson"), claims 11-13 and 18 were rejected under 35 U.S.C. section 103(a) as being unpatentable over Edelson in view of the On-line Medical Dictionary, claims 14-17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Edelson in view of the On-line Medical Dictionary and further in view of U.S. Patent No. 5,845,255 to Mayaud ("Mayaud"), claims 21-23 are rejected under 35 U.S.C. 103(a) as unpatentable over Edelson in view of U.S. Patent No. 5,597,995 to Williams et al. ("Williams") and the On-line Medical Dictionary, and claims 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edelson in view of Williams and the On-line Medical Dictionary and further in view of U.S. Patent No. 5,758,095 to Albaum et al. ("Albaum"). The Examiner is thanked for attention to the application.

Claims 1 and 16 are now amended, each to delete explicit reference to formulary records "comprising chemical composition and properties" of medications. That formulary records explicitly comprise "chemical composition and properties" was added by previous amendment. Claim 2 is also amended to change reference to acceptance and processing to simply reference to processing, as discussed later herein.

Claims 1-27 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. For example, claim 1 was rejected under 35 U.S.C., first paragraph, for reciting "the formulary records comprising chemical composition and properties of each of the medications, wherein the service center is configured to...the plurality of formulary records comprising chemical composition and properties for at least of the orders for medication...for medication", which allegedly is not found in the specification. Office action, p. 2-3.

As an initial matter, "The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of Mineral Separation v. Hyde, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied. In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988)." MPEP 2164.01. "There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is 'undue.' These factors include, but are not limited to:

(A) The breadth of the claims;

(B) The nature of the invention;

(C) The state of the prior art;

(D) The level of one of ordinary skill;

(E) The level of predictability in the art;

(F) The amount of direction provided by the inventor;

(G) The existence of working examples; and

(H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) (reversing the PTO's determination that claims directed to methods for detection of hepatitis B surface antigens did not satisfy the enablement requirement)... It is improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors while ignoring one or more of the others. The examiner's analysis must consider all the evidence related to each of these factors, and any conclusion of nonenablement must be based on the evidence as a whole. 858 F.2d at 737, 740, 8 USPQ2d at 1404, 1407." MPEP 2164.01(a)(emphasis supplied).

For claim 1, and claims 2-27 for that matter, the Office action fails to address any of the above factors, much less all the above factors, and the rejection of the claims under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement is therefore improper.

Nevertheless, as indicated above, claim 1 has been amended to delete explicit reference to formulary records as "comprising chemical composition and properties" of medications. In addition, it is noted that the application as filed states "In the embodiment described, the service center server supplies the pharmacy server at least one of the plurality of formulary records upon request by a pharmacy client system when an order is processed." Application as filed, p. 3, lines 20-23. See, also, application as filed, p. 6, lines 2-32 and claim 1 as originally filed. "In establishing a disclosure, applicant may rely not only on the description and drawing as filed but also on the original claims if their content justifies it. Where subject matter not shown in the drawing or described in the description is claimed in the application as filed, and such original claim itself constitutes a clear disclosure of this subject matter, then the claim should be treated on its merits, and requirement made to amend the drawing and description to show this subject matter. The claim should not be attacked either by objection or rejection because this subject matter is lacking in the drawing and description. It is the drawing and description that are defective, not the claim." MPEP 608.01(l); See, also, MPEP 2163.I.A ("There is a strong presumption that an adequate written description of the claimed invention is present when the application is filed. In re Wertheim, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976)...")

In rejecting claims 1-27 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement, the Office action indicates that the recitation of claim 2 of "each order record including order information for an order accepted and processed by the at least one pharmacy client system" is not found in the specification. This portion of claim 2 was found in originally filed claim 2. Moreover, the application as filed states that "The global database includes information pertaining to one or more pharmacy networks, such as records of the transactions between the service center network 21 and the pharmacy network 11. The global database further includes specific information concerning a particular request or order from a particular pharmacy for a particular patient and/or customer as well as formulary information for a customer of a specific pharmacy." Application as filed, p. 7, lines 6-14. In addition, the application as filed states "The global database contains information....The information in the global database is in the form of a series of records." Application as filed, p. 8, lines 31-35.

Nevertheless, claim 2 is now amended to delete reference to acceptance of an order. In view of the foregoing, it is believed that both claim 2 prior to amendment and claim 2 after amendment find support in the disclosure as filed.

Also In rejecting claims 1-27 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement, and immediately after indicating that portions of claim 2 is not found in the specification, the Office action states that claims 3, 6, 7, 10, 15, and 16 have a similar issue. As the Office action only pointed to a portion of claim 2, it is unclear from the Office action which portion of each of claims 3, 6, 7, 10, 15, and 16 are being referred to. In any event, claims 3, 6, 7, 10, and 15 are as originally filed, and claim 16, which was previously amended, only includes in substance text of claims as originally filed. Accordingly, for at least this reason it is believed that these claims have support in the original disclosure.

Claims 1 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite, both for reference to a service center client system. As stated in the Office action, the claims recite "'a service center client system' and nothing else is being done with the 'service center client sytem' after the reference to it..." Office action, p.3. Claims 1 and 16, prior to amendment, recited "a service center network including a service center server and a service center client system." Accordingly, the claims specified components of the service center network, and that "nothing else is being done with" one of the components would not appear to raise questions regarding the definiteness of the claims. Nevertheless, reference to the service center client system has been deleted from the claims, and the rejection is therefore moot.

Turning now to the rejections in view of art, claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Edelson.

Claim 1 specifies "wherein the service center server is configured to supply the pharmacy server at least one of the plurality of formulary records for at least one of the orders for medication upon request by the at least one pharmacy client system when the at least one of the orders for medication is processed." The Office action points to Figs. 6 and 7 of Edelson for disclosing such, and the Office action states that these figures "show downloaded formulary information sent to a local pharmacist as part of drug order processing." Office action, p. 5.

FIG. 6 of Edelson is a drug selection screen, condition specified, and FIG. 7 of Edelson is a nonformulary drug selection screen. Edelson, col. 6, lines 42-43. FIG. 6 of Edelson shows that a short, system-generated list of drugs known to be therapeutically indicated for a condition may be presented to a physician. Edelson, col. 34, lines 50-54. In the example of FIG. 6, the list of drugs are formularly drugs (Edelson, FIG. 6), which in the context of Edelson referes to a list of preferred drugs contained in a drug benefits plan issued by a drugs benefit provider to a given patient. Edelson, col. 1, lines 55-58. FIG. 7 of Edelson shows that a list of non-formulary drugs which may be displayed to the physician. See, e.g., Edelson, FIG. 7 and col. 35, lines 61-63. ("the physician can select Other, which selection displays a nonformulary drug list 122, under nonformulary drug header 124, as shown in FIG. 7.")

There appears to be nothing, however, with respect to FIGs. 6 and 7 of Edelson that indicate that a "service center server is configured to supply the pharmacy server at least one of the plurality of formulary records...when the at least one of the orders for medication is processed."

Further, as apparent from Edelson, the interface of FIGs. 6 and 7 of Edelson are provided by way of user interface devices and desktop computer, with the user interface devices and desktop computer in communication with a host computer facility. See, e.g., Edelson, col. 44, lines 16-20 and 50-53 ("Shown schematically in FIG. 16, are a number of user interface devices 200 and a desktop computer 201 communicating via any of a variety of communication services 202, through a gateway-router 204 with a host computer facility 206...Other prescribers (or other professionals in different environments) may use different methods to communicate with host computer facility 206..."). The host computer facility, in turn, is in data communications with remote databases. Edelson, col. 47, lines 9-10. In this regard, the Office action appears to equate "a pharmacy server" as specified in claim 1 with the host computer facility of Edelson. Office action, p. 4-5, pointing to col. 7, lines 16-27 of Edelson. Similarly, the Office action appears to equate the "service center server" of claim 1 with the remote database sources of Edelson. Office action, p. 5, pointing to col. 7, lines 28-32 of Edelson.

Importantly, however, in Edelson, "Drug and condition lists and some drug information are also maintained on the host computer facility 206, but these are preferably either synchronized or refreshed at intervals (e.g. overnight) from source databases of such drug information." Edelson, col. 46, lines 47-51. Thus, from Edelson, there appears to be no indication that the remote database sources "supply...formulary records...when the at least one of the orders for medication is processed," as specified by claim 1, or that there would be any reason to do so.

Edelson therefore does not disclose "service center server is configured to supply the pharmacy server at least one of the plurality of formulary records...when the at least one of the orders for medication is processed" as specified by claim 1, and the Office action provides no reasons why the such would be obvious in view of Edelson. "The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in KSR International Co. v. Teleflex Inc., 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that 'rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.' In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also KSR, 550 U.S. at ___ , 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval)." MPEP 2142.

Considering the foregoing, the rejection of claim 1 as obvious in view of Edelman is improper, and should be withdrawn. The rejections of claims 2-15, depending on claim 1, should also therefore be withdrawn.

Claim 16 specifies "wherein the service center server is configured to supply the pharmacy server at least one of the plurality of formulary records for at least one of the orders for medication upon request by the at least one pharmacy client system when the at least one of the orders for medication is processed." As discussed above regarding claim 1 and Edelson, Edelson does not disclose or make obvious that a "service center server is configured to supply the

pharmacy server at least one of the plurality of formulary records...when the at least one of the orders for medication is processed," and claim 16 and dependent claims 17-27 are therefore allowable in view of Edelson.

In addition, regarding claim 16, the Office action states that "The 'wherein' clause merely states the result of a limitation in the claim and is therefore given little patentable weight", and cites to several cases. Office action, p.12. As was stated in a prior response, it is not believed the cited cases support the conclusion reached by the Office action. Also as was stated in a prior response, considering for example the "wherein" clauses of claim 16, it does not appear that the "wherein" clauses merely state a result of a limitation in the claim. However, from the Office action, it appears that retention of the statement regarding wherein clauses on page 12 of the Office action may have been in the nature of a typographical error, as some treatment of matters relating to wherein material are treated with respect to Edelson in the subsequent paragraph of the Office action. If, however, the statement regarding the wherein clause on page 12 of the Office action was meant to be retained, with claim rejections on that basis, it is respectfully requested in view of the foregoing, that any such rejection be withdrawn.

Without attempting to be comprehensive, it is also noted that, at the portions cited by the Office action, Edelson does not appear to disclose what is attributed to Edelson. For example, claim 8 specifies that "modification to the ingredients of the medication include changes to amounts of caloric content in the medication." The Office action states that "With respect to claim 8, Edelson teaches, wherein updates to the modification to the ingredients of the medication include changes to amounts of caloric content in the medication (col. 32, lines 54-59)." Office action, p. 5.

Edelson at col. 32, lines 54-59, however, states "Other suitable information data retrieval and updating systems will be apparent to those skilled in the art and can be linked to the system of the present invention to provide allergy and interaction alerts, formulary changes, new drug approvals, and to lock out or warn against the prescribing of inappropriate or recalled drugs." In this section of Edelson, there appears no mention of caloric content. Accordingly, claim 8 is further allowable.

The same portion of Edelson is cited with respect to claim 9 for disclosing modification to the ingredients of the medication including changes to amounts and preferences of electrolytes in the medication. Again, in the cited section of Edelson, provide above, there appears no mention of electrolytes. Accordingly, claim 9 is further allowable.

Accordingly, the application is in condition for allowance, and allowance of same is respectfully requested.

Respectfully submitted,
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